

Remarks

Status of the Claims

Claims 1-248 are canceled and new claims 249-280 are added herein. Claims 249-280 are pending in the application.

Support for “selecting for the nucleic acid molecules generated in step (c) which contain (i) either the first or second positive selection marker, and (ii) do not contain the negative selection marker” is found, *inter alia*, at page 16, lines 3-21, and in Example 5. Support for “the first nucleic acid molecule further comprises an origin of replication” is found, *inter alia*, at page 32, line 21 of the specification. Support for “the second nucleic acid molecule further comprises one or more functional antibiotic resistance genes” is found, *inter alia*, in Figure 7C. Support for claims 252-254 is found, *inter alia*, at page 16, lines 8-17 and in Example 5. Support for “the selectable marker is an antibiotic resistance gene” is found, *inter alia*, at page 14, line 26, through page 15, line 2 of the specification. Therefore no new matter is added.

35 U.S.C. § 103(a)

Claims 187, 190-193, 196-199, 201-206, 210-211, 213, 216-217, 223-225, 228, 231-232, 235-237, and 247-248 stand rejected under 35 U.S.C. § 103(a) and being unpatentable over Fukushima *et al.* (*PNAS* 89:7905-09 1992), further in view of Abremski *et al.* (*J.Biol. Chem.* 259:1509-14 1984), Griffiths *et al.* (U.S. Patent No. 5,962,255), Senecoff *et al.* (*J.Mol. Biol.* 201:405-21 1988) and Johnson *et al.* (WO 1993/19172). (Office action, page 3.)

Claims 187-219, 223-225, 228-238 and 247-248 stand rejected 35 U.S.C. § 103(a) and being unpatentable over Fukushima *et al.*, Abremski *et al.*, Griffiths *et al.*, Senecoff *et al.*

and Johnson *et al.*, further in view of Lenski *et al.* (*J.Bact.* 176:3140-47 1994). (Office action, page 7.)

Claims 187-219, 223-225 and 228-248 stand rejected 35 U.S.C. § 103(a) as being unpatentable over Fukushima *et al.*, Abremski *et al.*, Griffiths *et al.*, Senecoff *et al.*, Johnson *et al.* and Lenski *et al.*, further in view of Wahl *et al.* (U.S. Patent No. 5,667,177). (Office action, page 8.) Applicants respectfully disagree.

Solely to advance prosecution and without admitting to the appropriateness of the pending rejections, Applicants have cancelled claims 187-219, 223-225 and 228-248 herein and added new claims 249-280. Applicants reserve the right to pursue the subject matter of claims 187-219, 223-225 and 228-248 in continuing applications.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. (*See* Manual of Patent Examining Procedure (MPEP) § 2142 (eighth edition, revision 5, August 2006).) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As amended herein, new independent claim 249 further recites “selecting for nucleic acids which contain a positive selection marker and which do not contain the negative selection marker.” None of Fukushima *et al.*, Abremski *et al.*, Griffiths *et al.*, Senecoff *et al.*, Johnson *et al.* and Lenski *et al.* or Wahl *et al.*, alone or in combination, teach or suggest this claim limitation.

Therefore, Applicants respectfully submit that a *prima facie* case of obviousness based on the disclosures of the cited references has not been established. Reconsideration

and withdrawal of the rejection of pending claims 249-278 under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed or otherwise overcome. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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